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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/170,234	10/13/98	SHAW	J 1123U101

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PM92/1117

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EXAMINER

HORTON, Y

ART UNIT	PAPER NUMBER
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3635

DATE MAILED:

11/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/170,234

Applicant(s)

JOHN G. SHAW

Examiner
Yvonne M. Horton

Group Art Unit
3635



☒ Responsive to communication(s) filed on Aug 30, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) 8-13 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 1

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of the rot protector as shown in Figures 1-3 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there is no patentable distinction between Figures 1-4 and Figures 4 and 5. This is not found persuasive because each of the aforementioned Figures detail a different variation or species of an elongated rot protector and the applicant, according to 35 U.S.C. § 121, is only allowed to have a single one of those variations or species prosecuted on the merits. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 8-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected wood rot protector, the requirement having been traversed in Paper No. 7.

Drawings

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show a decking "L" as described in the specification on Page 11 or no web "12" as described in the specification on Page 13. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

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Specification

5. The disclosure is objected to because of the following informalities: Page 10, line 5, --3-- should be inserted after "Figure". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is directed to a wood rot protector and not the actual wood member. Therefore, unless the applicant intends on claiming the combination, he is advised that he must claim the rot protector as being "adapted" for attachment, overlying, or in contact with the wood member. Claim 1 recites the limitation "the upper edge" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the underside" and "the load"; respectively, in lines 2 and 4. There is insufficient antecedent basis for this limitation in the claim.

In claim 3, it is confusing as to how the side walls make a "snug friction fit" over the lumber, especially if the side wall is defined in claim 1 as being "out of contact" with the lower portion of the lumber. The examiner understands that the ribs formed on the undersurface of the side walls allows the protector to have a "snug friction fit" over the lumber. However, it is not clear how or if the side walls themselves actually make the "snug friction fit".

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The "drip edges" of claim 6 appear to be repetitive of the "two side strips" of claim 1.

Claim 7 recites the limitation "the inner surface" and "the grooves"; respectively, in lines 1 and 3. There is insufficient antecedent basis for this limitation in the claim.

Allowable Subject Matter

8. Claim 1 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. ***This is provisional and subject to reconsideration upon receipt of claims amended in compliance with 35 U.S.C. § 112.***

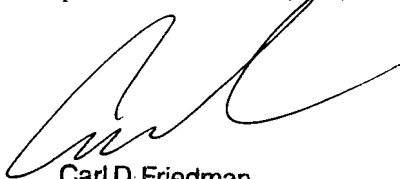
9. Claims 2-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. ***This is provisional and subject to reconsideration upon receipt of claims amended in compliance with 35 U.S.C. § 112.***

10. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach the use of a wood rot protector having a web, two angled side strips, and two side walls; wherein inner surfaces of the side walls have ribs thereon such that the side walls are out of contact with the wood once placed there over.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (703) 308-2168.

YMH

November 8, 1999



Carl D. Friedman
Supervisory Patent Examiner
Group 3600